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OFFICE OF PETITIONS

In re Application of
Robert J. Svoboda et al.
Application No. 10/797,301
Filed: March 9, 2004
Attorney Docket No. **DP-308342**

DECISION ON PETITION
UNDER § 1.183

This is a decision in response to the petition filed January 21, 2009, under 37 CFR § 1.183 for waiver of the requirement under 37 CFR § 1.131 that all of the inventors sign the declaration of prior inventorship.

The petition under 37 CFR 1.183 is **GRANTED**.

The above-identified application was filed on March 9, 2004, with a 37 CFR 1.63 declaration signed by all of the inventors. With the instant petition, applicants filed a 37 CFR § 1.131 declaration. The 37 CFR § 1.131 declaration has been executed by joint inventor Svoboda but not by joint inventor Keller. Applicants have filed the instant petition to have the 37 CFR § 1.131 declaration accepted as signed by joint inventor Svoboda on his own behalf and on behalf of non-signing inventor Joseph M. Keller.

37 CFR 1.131 states, in pertinent part:

When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference or activity on which the rejection is based.

In addition, the Manual of Patent Examining Procedure states that "an application or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection."

Here, there has not been a party qualified under 37 CFR 1.42, 1.43, or 1.47. In addition, applicants do not contend that less than all of the named inventors of the application invented the subject matter of the claims under rejection. Accordingly, the proper parties to sign the 37 CFR § 1.131 declaration include all of the joint inventors.

In order for a petition under 37 CFR § 1.183 to be granted to waive this requirement that joint inventor Keller sign the 37 CFR § 1.131 declaration, petitioner must demonstrate that this is an extraordinary situation where justice requires waiver of the rules.

On instant petition, applicants have set forth the steps taken to obtain joint inventor Keller's signature on the 37 CFR § 1.131 declaration. Applicants have shown that a bona fide effort was made to reach or locate inventor Keller to present the 37 CFR § 1.131 declaration and supporting documentation. The declaration presented is signed by joint inventor Svoboda. Under the circumstances, it is concluded that petitioner has demonstrated that this is an extraordinary situation, warranting waiver of the rules.

The petition is granted to the extent that the 37 CFR § 1.131 declaration may be entered, despite the fact that its requirement that all of the inventors sign the declaration has not been satisfied. This is not a decision on the merits of the declaration.

Petitioner is advised that the fee for a petition under 37 CFR 1.183 is set at \$400 not \$130 as indicated in the petition. As such, petitioner's deposit account no. 50-4635 has been appropriately charged in the amount of \$400.

This matter is being referred to Technology Center 1792 for consideration on the merits of the reply and the 37 CFR § 1.131 declaration, filed January 21, 2009.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

A handwritten signature in black ink, reading "Patricia Faison-Ball". The signature is written in a cursive, flowing style.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions